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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/673,358 | 09/26/2003 | Boris E. Paton | 7704.003DIV2 | 3805 |

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EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,358

Applicant(s)

PATON ET AL.

Examiner

Rosiland S. Rollins

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3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-41, 65-68 and 71-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-41, 65-68 and 71-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39, 65, 67, 71 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmaltz et al. (US 6050996).

In figure 1, Schmaltz et al. disclose an apparatus for bonding soft biological tissue having an incision therein, comprising: forceps **(10)** adapted to grip a portion of the tissue on both sides of the incision; electrodes **(11/12)** secured to the forceps for contacting the tissue portion; and an adjustable stop member **(31)** that limits the extent to which the forceps may be deformed, the stop member being adjustable to accommodate the bonding of tissues of varying thicknesses to provide tissue welding that forms a weld to reconnect the tissue.

Regarding claim 65, figure 1 of Schmaltz et al. illustrate the forceps having two arms, and the adjustable stop member being positioned between the two arms of the forceps.

Regarding claims 67 and 73 the ridges illustrated in figure 1 of Schmaltz et al. are understood by the Examiner to be one or more spacers.

Claims 39 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Buysse et al. (US 5776130).

In figure 2, Buysse et al. disclose an apparatus for bonding soft biological tissue having an incision therein, comprising: forceps **(16)** adapted to grip a portion of the tissue on both sides of the incision; electrodes **(23)** secured to the forceps for contacting the tissue portion; and an adjustable stop member **(22)** that limits the extent to which the forceps may be deformed, the stop member being adjustable to accommodate the bonding of tissues of varying thicknesses to provide tissue welding that forms a weld to reconnect the tissue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 41, 66 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al.

Schmaltz et al. teach all of the limitations of the claims except the electrodes being made of a metal with a high heat conductivity, the electrodes being dimensioned

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to have a volume which is at least 5 times that of the tissue portion volume and the lug being replaceable.

Regarding claim 40, it would have also been obvious to the artisan at the time the invention was made to provide electrodes dimensioned to have a volume which is at least 5 times that of the tissue portion volume, since it has been held that discovering the optimum dimension involves only routine skill in the art.

Regarding claim 41, it would have been obvious to the artisan at the time the invention was made to provide electrodes made of a metal with a high heat conductivity, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claims 66 and 72, Examiner takes official notice that the artisan would consider the stop member disclosed by Schmaltz et al. to be a lug. Schmaltz et al. fail to disclose the lug as being replaceable. It would have been obvious to the artisan to make the lug replaceable, since it has been held that the provision of an article being replaceable involves only routine skill in the art.

Claims 68 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. further in view of Choudhury (US 5219354).

Schmaltz et al. teach all of the limitations of the claims except the adjustable stop member comprising an adjustable knob.

Choudhury disclose a forceps device that includes an adjustable stop member that comprises an adjustable knob **(51)**, which provides an automatic lock release

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system for the forceps. Therefore, it would have been obvious to the artisan to provide an adjustable knob on the stop member of Schmaltz et al. as taught by Choudhury to lock the forceps in place once applied to the treatment area.

Response to Arguments

Applicant's arguments filed 12/23/05 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the stop member preventing the user from exerting too much force on the tissue by resisting any increased pressure from the surgeon's fingers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that at the time of the invention it could not have been possible to deduce the optimum dimension and material of the electrode from the Schmaltz prior art. Examiner agrees that Schmaltz is silent as to the specific volume and material of the electrodes. However, the claimed dimensions and material is obvious in light of Schmaltz as both the reference and instant application relate to bonding tissue. As such it is the Examiner's position that through routine experimentation motivated by the desire to optimize the Schmaltz device, one of ordinary skill in the art would have determined the claimed dimension and material of the electrode.

Regarding the argument that one skilled in the relevant art would not consider the stop member disclosed by Schmaltz et al. to be a lug. Examiner has provided Grismer (US 5133737) as prior art supporting the official notice that one of ordinary skill in the art would consider the stop member disclosed by Schmaltz et al. to be a lug.

Regarding the Choudry reference, Applicant relies on the argument that the prior art does not prevent overexertion of pressure upon the handles. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

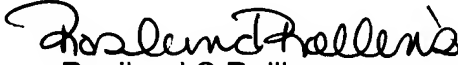
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
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